

M. G. M. LOGISTICA



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 4778
 Claudio ZAMPIERI : Attorney Docket No. 2005_1196A
 Serial No. 10/549,857 : Group Art Unit 3618
 Filed September 23, 2005 : Examiner Cynthia F. Collado
 IN-LINE ROLLER-SKATE FOR RACING : Mail Stop: AF
 (AS AMENDED)

DECLARATION UNDER 37 CFR 1.132

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

I, Mr. Enzo Prandina hereby state the following facts for consideration in the above-referenced U.S. patent application:

1. My employment history is as follows:

1969-1971 Production Manager Nordica Spa (ski boots)
 1972-1974 R&D Manager Nordica Spa (ski boots)
 1975-1977 R&D Manager Caber Spa (Spalding Group) (ski boots)
 1978-1989 President C.E.O. Brixia Spa (brands: Brixia, Munari, S.Marco) (ski boots)
 1990-1995 Manager Director H.T.M. (brands: Head, Tyrolia, Mares)
 1996-Now President C.E.O. M.G.M. Spa (brands: Fila, Hypno inline-skates, Trezeta outdoor shoes)

2. In view of my employment history as described above, I have personal knowledge, or knowledge gained on information and belief, of the facts which are presented in this Declaration.

3. MGM S.p.A. developed the so-called "big wheel" concept for in-line skates. The "big wheel" concept for in-line skates corresponds to new claim 5 of the above-referenced U.S. patent application, set forth as follows:

Claim 5 (Currently Amended) An in-line roller skate for racing, comprising:
a footwear having a sole on the bottom thereof, said sole having a heel-piece zone and a toe juncture area corresponding to an area of a foot where the toes of the foot join the foot;
a chassis supporting at least four wheels including a front wheel and a second wheel immediately behind said front wheel, said front wheel and said second wheel being located in a front zone of said chassis;
at least first and second binding points on said sole attaching for attachment of said sole to said chassis, said first binding point being positioned in proximity of said heel-piece zone of said sole, and said second binding point being positioned approximately in the a-toe juncture area of said sole;
fasteners ~~for~~ joining said footwear to said chassis at said first and second binding points, said second binding point being located between said front wheel and said second wheel;
wherein said at least four wheels are solely wheels having a diameter of at least 100 mm; and
~~wherein a height of said front zone of said chassis in relation to a ground contact plane of said at least four wheels is substantially equal to said diameter of said at least four wheels,~~
wherein a center to center distance between said first and second binding points is between 170 mm and 210 mm.

In July of 2003 FILA Skates officially presented to the market the 100 mm set up incorporating our big wheel concept. As soon as the big wheel concept was introduced into the

market for the '03-'04 season, the sales of models with 80/84 mm wheels in the Racing and Marathon segments of the market dropped dramatically. Year after year consumers have recognized the benefit of our invention both from a performance and comfort point of view. Sales of our models are constantly growing. This is confirmed from Exhibit A attached hereto.

4. The big wheel 100 mm set up of the present invention, introduced to the market by FILA Skates in July of 2003, was used by the FILA Skates international team from the beginning of the 2003 World In-Line Cup. The FILA team, thanks to this solution, won almost all of the races, and won three In-Line Cups in a row. While other skaters switched to the new set up as fast as possible, they needed time to train and adapt to the new skates.

Thus all major competitors followed the concept of the present invention, which is now commonly used. The solution according to the present invention was presented by FILA Skates, in the first market year (the 2004 collection) on two models of the Speed segment of the market. Please see enclosed Exhibit C. From Exhibit C, it may be seen that upon the introduction into the market of the 100 mm big wheel concept according to the present invention by FILA, no other major in-line skate brands were presenting any similar model. Then, in the following season, most of the brands came out with a similar model. Turning to Exhibit D, it can be seen that for the 2005 market year for the Speed segment, K2 came out with a similar solution. Salomon had found a compromise that never had success (3 x 100 mm + 1 x 84 mm in order to be able to keep the 165 mm frame/boot mounting space). Roller blade also followed suit, as can be seen from the Problade and Pro Marathon models in Exhibits E and F.

In the Fitness segment of the market, for the 2004 market year, FILA Skates had used a 90 mm wheel for its top-of-the-line fitness skate. However, thanks to the great success with the 100 mm set up, the 100 mm set up was introduced as the top of the line skate for the 2005 market year collection, which is the M100 model as can be seen from Exhibit H. An advantage for fitness skaters is also huge in that bigger wheels means more comfort, as the bigger wheel rolls better, absorbing vibrations on rough surfaces. K2 followed in the same way, Salomon again went with its compromise, and eventually everybody turned to the same solution as developed in the present invention. See for example Exhibits I and L.

5. As reflected by the discussion in the above-referenced patent application, the big wheel 100 mm set up according to the present invention results in better maneuverability and

faster speed. To help understand why this is the case, attached is a summary of a study made by the Italian Skating Federation as Exhibit M. As reflected in the summary, moving the boot/frame connection to 195 mm, for example, it is possible to maintain the same ground clearance as with the 5 x 84 mm set up and to fix the wheels at the same distance one to the other. On the contrary, with the 165 mm boot/frame connection, between the first and the second wheel there should be more space. But in this situation, it has been demonstrated that, especially in curves, there is a speed reduction. The low balance of the solution according to the present invention provides greater stability and increased control and sensitivity. Statistical reports of the FIHP demonstrates that the 4 x 100 mm set up according to the present invention provides 4% additional speed as compared to the previous 5 x 84 mm set up.

6. The World In-Line Cup is an event that is organized outside of partnership with official skating federations. Accordingly, it is an event where skaters have the opportunity to experiment with new solutions. The same skaters were then competing in the world championships and were pushing hard to be able to skate with a best performing set up. When competing in the World In-Line Cup with 4 x 100 mm wheels, they realize these wheels were faster. Then, they went to the world championships and had to race with 5 x 84 mm wheels. Their performance with a 5 x 84 mm wheels was so poor for them in comparison that the skaters themselves pushed the federation to change the rules to allow the world championships to be conducted with the 4 x 100 mm big wheel concept according to the present invention. The skating federations then changed their rules in 2005. Attached Exhibits B1 and B2 are two pages, numbered 12 and 68 respectively, which evidence the fact that the rules have been changed to allow for the 100 mm set up.

7. I further declare that all statements made herein of my own knowledge are true and that all statements on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

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Jan. 17, 2008
Date


Mr. Prandina (Signature)